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EXAMINER
ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Office Action Summary	Application No.	Applicant(s)
		09/943,894	ANDERSON, ERIC D.
		Examiner	Art Unit	
		David E. England	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _18 November 2004_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under _Ex parte Quayle_, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _11 – 29 and 37 – 44_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _11 – 29 and 37 – 44_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _29 August 2001_ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 20050210

DETAILED ACTION

1.   Claims 11 – 29 and 37 – 44 are presented for examination.

Drawings

1.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every

feature of the invention specified in the claims. Therefore, the "providing an Email

communication program on a server that performs the acts of: <u>receiving an indication of an

Email communication</u>" must be shown or the feature(s) canceled from the claim(s). No new

matter should be entered.

2.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every

feature of the invention specified in the claims. Therefore, the "<u>If it is determined that multiple

recipients have been indicated</u>: <u>storing a single copy</u> of the Email communication on the server"

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3.   The drawings are objected to under 37 CFR 1.83(a). The drawings must show every

feature of the invention specified in the claims. Therefore, the "<u>**If** it is determined that multiple

recipients **have not** been indicated</u>: <u>sending the Email communication to the recipient **without**

waiting for a request</u> for the Email communication" must be shown or the feature(s) canceled

from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment

of the application. Any amended replacement drawing sheet should include all of the figures

appearing on the immediate prior version of the sheet, even if only one figure is being amended.

The figure or figure number of an amended drawing should not be labeled as "amended." If a

drawing figure is to be canceled, the appropriate figure must be removed from the replacement

sheet, and where necessary, the remaining figures must be renumbered and appropriate changes

made to the brief description of the several views of the drawings for consistency. Additional

replacement sheets may be necessary to show the renumbering of the remaining figures. The

replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR

1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

by the examiner, the applicant will be notified and informed of any required corrective action in

the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

5.   Claims 11, 23, 37 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains,

or with which it is most nearly connected, to make and/or use the invention. The limitation of,

"providing an Email communication program on a server that performs the acts of: receiving an

indication of an Email communication," is not found in the specification. This limitation leaves

one to believe that a server will receive an Email communication, when in fact; it is a user or at

least one recipient that will "receiving an indication of an Email communication" from a server.

6.   Claims 11, 23, 37 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains,

or with which it is most nearly connected, to make and/or use the invention. The limitation of,

"**If it is determined that multiple recipients have been indicated**: storing a single copy of the

Email communication on the server," is not found in the specification. This limitation leaves one

to interpret that an Email communication is not stored on the server until multiple recipients have

been indicated. This is not supported by the specification as stated on page 9, lines 25 – 30, page

10, lines 14 – 19 and page 10, line 23 – page 11, line7 of the Applicant's application. In these

sections, it is stated that once the server has stored the Email communication and information

about the recipients, and **then the server sends an indicator to at least one recipient**. Furthermore,

the specification states that after a recipient receives an indicator, one can store "**a copy** of the

message in a physically distinct server location, (e.g. page 11, line 1)", (e.g. "*in a particular

folder.*" Page 10, lines 28 – 29 of Applicant's application). Also, the application states that,

"*Defaults can also affect whether various actions are available or needed (e.g. if a default

behavior is to save a message unless it is explicitly deleted, a save instruction form a recipient is

not necessary).*" This is stated after the section about storing in a particular folder and would

leave one to believe that a recipient could have a copy of the original Email communication

stored in a different location exclusive to that recipient. It would not seem efficient for a system

to have only a single copy continually be saved and transferred to different locations in a server

every time a different recipient received an indicator and cause the server to devote more

resources to transferring the single copy then deem necessary.

7.   Claims 11, 23, 37 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains,

or with which it is most nearly connected, to make and/or use the invention.

8.   The limitations of, "**If it is determined that multiple recipients have been indicated**:

notifying each of the multiple recipients of the Email communication without sending the Email

communication to the recipients," is not found in the specification as to a condition from an

indication of multiple recipients leads to another type of notification to the same multiple

recipients.

9.   Claims 12, 38 and 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains,

or with which it is most nearly connected, to make and/or use the invention.

10.   The limitations of, "**If it is determined that multiple recipients have not been indicated**:

sending the Email communication to the recipient **without waiting for a request** for the Email

communication," is not found in the specification as to a condition for not indicating multiple

recipients. Furthermore, in claims 38 and 42 there is mention of "the Email communication

program is further configured to perform the acts of:", there is no mention of the Email

communication program performing this condition. In fact, on page 10, lines 14 – 16 of the

Applicant's application, it states, *"In one embodiment, the Message Receiver retrieves the stored

message **without the intervention of the MDS system** ... "*. This would leave one to interpret that

there is no "Email communication program" intervention with an Email communication.

11.   Claims 18 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the enablement requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention.

12.   The limitations of, "**retrieving** notifying instructions **for a recipient by the Email**

communication program," is not found in the specification. Claim 27 is rejected for similar

reasons, more specifically to the act of "retrieving" the sending instructions for the recipient. The

specification states that the recipient sends a "request", (e.g. Fig. 6, 605 & Fig. 7, 705).

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
> 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that
> the subject matter as a whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14.   Claims 11 – 13, 16 – 24, 27 – 29, 37 – 39 and 41 - 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848).

15.   As per claim 11, as closely interpreted by the Examiner, Dillon teaches a computer-implemented method for sending an Email communication to recipients, the method comprising:

16.   providing an Email communication program on a server that performs the acts of:

17.   receiving an Email communication, including an indication of at least one recipient to receive the Email communication, (e.g. col. 1, line 25 – col. 2, line 38);

18.   if it is determined that multiple recipients have been indicated,

    a.   storing a single copy of the Email communication on the server, (e.g. col. 3, lines 12 – 65);

    b.   notifying each of the multiple recipients of the Email to communication without sending the Email communication to the recipients, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, lines 12 – 65);

19.   in response to a request for the Email communication from a recipient, sending the Email communication to the recipient, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, lines 12 – 65).

Dillon does not specifically teach determining by the Email communication program, whether multiple recipients of the Email communication have been indicated in the received indication.

20.   Arnold teaches determining by the Email communication program, whether multiple recipients of the Email communication have been indicated in the received indication, (e.g. col.

4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because it would be more efficient for a system to acknowledge when multiple recipients have been indicated so if the sender needed to know which recipient did not receive an Email the sender could resend the Email to the recipients that are missing the Email or have misplaced it.

21.   As per claim 12, as closely interpreted by the Examiner, Dillon teaches if it is determined that multiple recipients have not been indicated, sending the Email communication to the recipient without waiting for a request for the Email communication, (e.g. col. 1, line 25 – col. 2, line 6).

22.   As per claim 13, as closely interpreted by the Examiner, Dillon teaches the use of storing and sending Email communication but does not specifically teach tracking the sending of the Email communication to the recipients; and

23.   when the Email communication has been sent to all of the recipients, deleting the stored Email communication by the Email communication program. Arnold teaches tracking the sending of a communication to the recipients, (e.g. col. 4, line 25 – col. 5, line 25); and

24.   when a communication has been sent to all of the recipients, deleting the stored Email communication by the Email communication program, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold's limitation of deleting an attachment after all recipients have viewed it with Dillon's limitation of storing Email because it is common for systems to utilize a Email server to store

Email for recipients and if a group of recipients have all viewed the Email and no longer desire

the use of the stored Email on the Email server then it would be advantageous for the Email to be

deleted so the Email server can have more space for other Emails that are to be sent.

25.   As per claim 16, as closely interpreted by the Examiner, Dillon does not specifically

teach determining a period of time for which the Email communication will be stored; and

26.   when the determined period of time has expired, deleting the stored Email

communication by the Email communication program. Arnold teaches determining a period of

time for which the Email communication will be stored, (e.g. col. 4, line 25 – col. 5, line 25); and

27.   when the determined period of time has expired, deleting the stored Email

communication by the Email communication program, (e.g. col. 4, line 25 – col. 5, line 25). It

would have been obvious to one skilled in the art at the time the invention was made to combine

Arnold with Dillon because of reasons disclosed above, furthermore, if a user has information

that is forgotten for a period of time, the system could delete this information, therefore freeing

up space in memory.

28.   As per claim 17, as closely interpreted by the Examiner, Dillon teaches wherein the

notifying of a recipient of the Email communication involves sending a distinct indicator Email

communication to the recipient by the Email communication program, (e.g. col. 9, line 60 – col.

10, line 40).

29.   As per claim 18, as closely interpreted by the Examiner, Dillon teaches including

retrieving notifying instructions for a recipient by the Email communication program, and

wherein the notifying of the recipient is performed according to the notifying instructions, (e.g.

col. 3, line 36 – col. 4, line 41).

30.   As per claim 19, as closely interpreted by the Examiner, Dillon does not specifically

teach wherein the notifying instructions are supplied by a sender of the Email communication.

Arnold teaches wherein the notifying instructions are supplied by a sender of the Email

communication, (e.g. col. 4, line 25 – col. 5, line 25). It would have been obvious to one skilled

in the art at the time the invention was made to combine Arnold with Dillon because if the sender

needed specific functions to be carried out with the Email communication it would be more

efficient for a system to have the sender send instructions to a Email server to only allow specific

recipients in a group to access the Email communication, delete the Email at a specific time,

automatically send the Email to recipients at a specified time, etc.

31.   As per claim 20, as closely interpreted by the Examiner, Dillon teaches wherein the

notifying instructions are supplied by the recipient, (e.g. col. 3, line 36 – col. 4, line 41).

32.   As per claim 21, as closely interpreted by the Examiner, Dillon does not specifically

teach wherein the notifying instructions are determined automatically by the Email

communication program based on past interactions with the recipient. Arnold teaches wherein

the notifying instructions are determined automatically by the Email communication program

based on past interactions with the recipient, (e.g. col. 5, line 25 – col. 6, line 49). It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because it is a more efficient way to have a Email communication dealt with, therefore saving time on the users side.

33.   As per claim 22, as closely interpreted by the Examiner, Dillon teaches wherein the notifying instructions indicate that the notifying is to be performed in an encrypted manner, (e.g. col. 9, line 60 – col. 10, line 14).

34.   Claims 23, 24, 27 – 29, 37 – 39 and 41 - 43 are rejected for similar reasons as stated above.

35.   Claims 14, 15, 25, 40 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848) in further view of Foladare et al. (6311210) (hereinafter Foladare).

36.   As per claim 14, as closely interpreted by the Examiner, Dillon and Arnold do not specifically teach when it is determined that the Email communication has been sent to all of the recipients and that none of the recipients have indicated that the Email communication is to be saved, deleting the stored Email communication by the Email communication program. Foladare teaches when it is determined that the Email communication has been sent to all of the recipients and that none of the recipients have indicated that the Email communication is to be saved,

deleting the stored Email communication by the Email communication program, (e.g. col. 3, lines 15 – 35). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Dillon and Arnold because if the Email communication is no longer needed, the user could have it deleted, therefore freeing up space on the system.

37.   As per claim 15, as closely interpreted by the Examiner, Dillon and Arnold do not specifically teach when it is determined that the Email communication has been sent to all of the recipients and that all of the recipients have indicated that the Email communication can be deleted, deleting the stored Email communication by the Email communication program. Foladare teaches when it is determined that the Email communication has been sent to all of the recipients and that all of the recipients have indicated that the Email communication can be deleted, deleting the stored Email communication by the Email communication program, (e.g. col. 3, line 55 – col. 4, line 15). It would have been obvious to one skilled in the art at the time the invention was made to combine Foladare with the combined system of Dillon and Arnold because in case a user makes the mistake of deleting information or is unsure if the information selected for deletion is correct, the system would have to have permission to delete the information. This could be used in a form of error checking.

38.   Claims 25, 40 and 44 are rejected for similar reasons as stated above.

39.   Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561)

in view of Arnold (6275848) in further view of Landfield et al. (5632011) (hereinafter

Landfield).

40.   As per claim 26, as closely interpreted by the Examiner, Dillon and Arnold do not

specifically teach automatically sending the Email communication to a non-recipient authorized

to access the Email communication. Landfield teaches automatically sending the Email

communication to a non-recipient authorized to access the Email communication, (e.g. col. 6,

lines 60 – 67). It would have been obvious to one skilled in the art at the time the invention was

made to combine Landfield with the combined system of Dillon and Arnold because if there is

Email communication data that would have information that is dangerous to the system an non-

recipient authorized to access the Email communication, (i.e. administrator), could check it for

harmful information that could damage the system.

Response to Arguments

41.   Applicant's arguments filed 11/18/2004 have been fully considered but they are not

persuasive.

42.   In the Remarks, Applicant argues in substance that Examiner has improperly convoluted

the distinction between the 112, first paragraph, "written description" requirement and the

"enablement requirement." There is no assertion by the Examiner that one of ordinary skill in the

art is not able to make and use the claimed invention without undue experimentation based on

the specification. Moreover, with respect to software, which is the field for the best mode for

implementing the present invention, the Federal Circuit has held that "[a]s a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure the function of the software. This is because, normally, writing code for such software is within the skill of the art, not required undue experimentation, once its functions have been disclosed.

43.   As to part 1, Examiner disagrees with the Applicant's assumption on the improper 112, first paragraph rejection. The intent of the Examiner was to point to section of the application that would leave one of ordinary skill in the art to believe that the claim language of the Applicant's invention could not be done without undue experimentation because of what is taught in the specification verses what is actually claimed. Although these rejections could be placed under 112, first paragraph regarding "written description", the format of the rejections and descriptions written by the Examiner were designed to provoke the Applicant to confirm or deny the steps in the specification, in correlation with the Figures, by pointing to and discussing the correct sections, whether it being the ones pointed out by the Examiner or not, that could enable a person skilled in the art to make and use the claimed invention without undue experimentation because of the misleading language of the claimed invention.

44.   Applicant as also stated that, "Applicant will accordingly proceed to address the rejection under section 112, presuming that the Examiner intended to draw the rejections under the written description requirement rather than the enablement requirement of 112, first paragraph.

45.   Therefore, the Examiner will attempt to respond to the Remarks with the intention of "enablement" while discussing points that could be made about the Applicant's "written description".

46.   In the Remarks, Applicant argues in substance that the Examiner has overlooked that the present claims use the same language as the original claims, or merely rephrase the language to clarify the invention. "It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification." MPEP 2163.(I).

47.   As to part 2, Examiner disagrees with the Applicant. If the Applicant would review previous amendments to the claims they would see that there is more then "mere rephrasing the language to clarify the invention". Since the "original filing" the Applicant has amended "electric communication", (which could be interpreted as any communication that is electrically sent over a medium, i.e. ping, telephone call, Morse Code, etc.), to an "Email communication" which has changed the scope of the claim. Furthermore, if Applicant were to review the telephonic interview notes dated 05/26/2004, it was stated that,

48.   "Examiner Attorney had come to an agreement that the amendments to the claims to bring out that the indication of an email communication is to a server with a type of program as oppose to a user would overcome the references as cited, but would require further search and consideration." Therefore, there as been substantial amended language added and taken away from the original filed claims that has changed the scope of the claims.

49.   In the Remarks, Applicant argues in substance that there is implicit and explicit support

for this limitation in specification as a whole and in the original filed claims for the limitation of

"if it is determined that multiple recipients have been indicated, storing a single copy of the

Email communication on the server."

50.   Applicant points to the Background section, which they say makes it clear that the

context of the invention is for when multiple recipients are designated. For example to contrast

with the problems of the prior art, at page 1, line 16 of the Applicant's application which stated,

"For example, when an electronic message is to be sent to multiple recipients, current messaging

systems deliver a separate copy of the message from the sender's system to each of the

recipients' system... Each recipients system that receive the message is then responsible for

storing and managing the message." By implication, the claimed method, which solves the

problem by storing a single copy of the message, is used in cases when multiple recipients are

designated.

51.   As to part 3, Applicant points out subject matter that is in the background of the

invention, which is well known in the art. The Applicant does not point to any section of the

specification that is not prior art and is unique from the Applicant's invention. The claim

language and the specification still do not enable one of ordinary skill in the art to make or use

the claim limitation without undue experimentation, nor has the Applicant pointed to any

sections of the Figures that would aid in the process of enabling the novelty in the Applicant's

invention, more specifically a conditional item in a figure that would suggest an "if, then, else"

type Boolean function, In re Donohue, 550 F.2d 1269, 1271, 193 USPQ 136, 137 (CCPA 1977)

("Employment of block diagrams and descriptions of their functions is not fatal under 35 U.S.C.

112, first paragraph, providing the represented structure is conventional and can be determined without undue experimentation."). For the possibility of a 112, first paragraph rejection under "written description", the Applicant has not disclosed any teachings or pointed to any sections in the specification, that is not prior art, or drawing that would prove the or disprove the Examiner interpretation.

52.   In the Remarks, Applicant argues in substance that paragraphs 7 – 14 of the Office Action dated 08/13/2004 are aimed at the same subject matter stated above. Again, because the terms were in the originally filed claims, which form part of the specification, there is adequate support for the claims. Again, with respect to the question of enablement, the claims terms do not require any further description in the specification to enable one of ordinary skill in the art to design and Email communication program with the recited limitations, because implementation is simply a matter of one of ordinary skill in the art writing code to perform the recited acts.

53.   As to part 4, Examiner would like to point to the above responses, for there is similar point that can be made in this response. Furthermore, the rejection does not mention, in any part, about the recited limitation not being enabling because of writing code to perform the recited acts. It is the specific steps that the limitation which is questionable. It is understood that writing code can be used to make programs, but how one of ordinary skill in the art go through the steps in the claimed language is a different matter. The Applicant only points to sections of the Background of the Invention that is well known in the art and does not point out in any part of the response or non-prior art areas, (i.e. the novel teachings in the Applicant's invention), that

would prove that the invention can be determined without undue experimentation. This also

holds true for the above responses to the Applicant's Remarks.

54.   In the Remarks, Applicant argues in substance that the Examiner's statements with

respect to claims 11, 23, 37 and 41 that is misleading to if [sic] there are two different types of

indicators to notifications. Applicant states that using plain meaning, one of ordinary skill in the

art would understand that an "indication" differs from "notifying". An "indication in the context

of "If it is determined that multiple recipients have been indicated" as recited in the claims 11,

23, 37 and 41, means information that is less than an entire Email communication and

particularly regarding the number of recipients. Such information may, for example, be

contained in the "To" line of an Email address. A "notification" on the other hand (or more

precisely, the act of "notifying") is sending a recipient information regarding the existence of the

Email, but which is less than the whole Email (i.e., without sending the Email communication to

the recipients).

55.   As to part 5, Examiner acknowledges the Applicant's differentiation between

"indication" and "notifying". In the claim language the Applicant will now be bound to the

definition of a "indication" or that step of "being indicated" is having users email addresses in

the "To" line, which is well known in the art.

56.   Rejection regarding part 5 has been withdrawn.

57.   In the Remarks, Applicant disagrees with in substance that the Examiner's rejection of

claims 18 – 22 under section 112, second paragraph for reciting the limitation "notifying

instructions". The plain meaning of "notifying instructions" is instructions (i.e., acts to take) to

notify a recipient. The specification plainly teaches, for example, at page 9, lines 6 and

following: "As discussed in greater detail with respect to Figure 2, the Message Tracking Table

stores information that instructs the MDS system on how and when to send messages and

indicators to recipients and stores record of when actions were taken or of the instructions from

recipients." Applicant also quotes a section on page 10, line 11, which states "When the user

indicates that they wish to review a message corresponding to a message indicator, the Message

Receiver users the message reference information in the message indicator to retrieve the stored

message."

58.   As to part 6, Examiner acknowledges the sections of specification that the Applicant has

pointed to and holds the meaning of "notifying instructions" to these sections quoted by the

Applicant.

59.   Rejection regarding part 6 has been withdrawn.

60.   In the Remarks, Applicant argues in substance that because Dillon is silent about

indications of multiple recipients, that are disclosed by the Examiner in the rejection, it is

axiomatic that Dillon does not teach "notifying each of the multiple recipients of the Email to

communication [sic] without sending the Email communication to the recipients." Dillon makes

no references at all to multiple recipients for the same Email communication. Therefore, the acts

of storing a single copy of the message if multiple recipients have been indicated is not taught or

suggested by Dillon.

61.   As to part 7, because of the Remarks regarding "indication/ indicated" where that it is

now known to be the Email addresses in the "To" field of an Email communication, the language

of the claims know has a more specific meaning and can know be better applied to the prior art.

The Applicant is asked to view Dillon column 2 and 3, more specifically the paragraph the goes

from column 2 to column 3, in which it states, "As will be explained in more detail below, the

present invention can be readily integrated with many existing e-mail systems with little or no

modification of such systems and provides e-mail notifications directly to the computer terminals

of e-mail alert service subscribers." Examiner would like to note that having more than one

Email address in the "To" field of an Email communication is well known in the prior art and if

the reference of Dillon can provide Email notifications directly to the computer terminals of

Email alert service subscribers, (plural), then it would be almost inherent that the system of

Dillon could send out notification that are addressed to more than one Email communication in

an Email communication that is addressed to multiple subscribers.

62.   In the Remarks, Applicant argues in substance that Arnold does not teach storing the

Email message, based upon whether multiple recipients have been indicated. Indeed, Arnold

teaches nothing at all about treating the Email message based upon whether multiple recipients

have been indicated.

63.   . As to part 8, in response to applicant's arguments against the references individually, one

cannot show nonobviousness by attacking references individually where the rejections are based

on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In

re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

64.   Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a
general allegation that the claims define a patentable invention without specifically pointing out
how the language of the claims patentably distinguishes them from the references.

65.   Furthermore, Arnold teaches whether multiple recipients have been indicated, (col. 4,
lines 19 and 20, *"meeting certain criteria (e.g., message size, number of recipients, etc.)"*.

66.   In the Remarks, Applicant argues in substance that the motivation for combining Arnold
with Dillon stated by the Examiner is not supported by the teaching in Arnold or Dillon, but
rather by hindsight reading of those references in view of the present Application. Applicants
submit that this motivation is supplied by the Examiner not by the references, because no such
efficiency is taught, suggested or stated to be desirable in the systems described by Arnold and
Dillon.

67.   Moreover, even if one would combine Arnold and Dillon for other reasons, these reasons
would not lead one of ordinary skill in the art to the same. Dillon is directed toward sending
notifications (alerts) of Email messages to recipient's using a hybrid network that transmits
notifications via a continuous high speed channel, while Arnold is directed toward a method of
detaching attachments from Email messages, storing the attachments on the Internet and sending
a notification message with an embedded URL, address for the stored attachment to the
recipients. The combination of Arnold and Dillon might provide motivation to one of ordinary
skill in the art to send notifications devoid of attachments described by Arnold using the
continuous high speed channel taught by Dillon. This is not relevant to, and does not suggest,

storing a single copy of the email message based on whether there is an indication of multiple users.

68.   As to part 9, Examiner would like to draw the Applicant's attention to the Access list that is stated in Arnold, in which the motivation is stated, (col. 5, lines 51 – 57). This modification to the access list would enable a user that was once not included in the Email, to be given a chance to view the message that was originally sent. This along with other motivations can be found throughout Dillon and Arnold.

69.   In the Remarks, Applicant argues in substance that Foladare not Landfield cure the deficiencies of Dillon and Arnold.

70.   As to part 10, Examiner disagrees with Applicant and asks the Applicant to draw their attention to the above response to their Remarks. Furthermore, all other Remarks can be addressed for the same reasons as stated above.

71.   In the Remarks, Applicant does not argue in substance any of the Drawing Objections nor does the Applicant point to any sections of the specification that could be read into the drawings. Therefore, Examiner will not withdraw the Drawing Objections as they stand.

Conclusion

72.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David E. England whose telephone number is 571-272-3912.

The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

De *DL*

DAVID WILEY
SUPERVISORY PATENT EXAMINER
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